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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,946	02/25/2004	Robert Gerald Taylor	030312TAYLOR	3785

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EXAMINER

MENDIRATTA, VISHU K

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/786,946

Applicant(s)

TAYLOR, ROBERT GERALD

Examiner

Vishu K Mendiratta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Specification***

1. The disclosure is objected to because of the following informalities: The drawing Fig.1 is not true to the specification as understood from page 9, lines 10-15. A total of three ( $2+1=3$ ) or nine ( $6+3=9$ ) can be rolled in one only way similar to a total of two ( $1+1=2$ ) or twelve ( $6+6=12$ ). The drawing demonstrates two spaces each on lanes 2 and 12, but three spaces on lines 3 and 11. This is not consistent with the "inversely proportional rule" as in specification.

Appropriate correction is required.

2. Claims 1-2 objected to because of the following informalities:

The drawing Fig.1 is not true to the specification as understood from page 9, lines 10-15. A total of three ( $2+1=3$ ) or nine ( $6+3=9$ ) can be rolled in one only way similar to a total of two ( $1+1=2$ ) or twelve ( $6+6=12$ ). The drawing demonstrates two spaces each on lanes 2 and 12, but three spaces on lines 3 and 11. This is not consistent with the "inversely proportional rule" as in specification.

Appropriate correction is required.

3. Claim 1 objected to because of the following informalities: A claim should be in a single sentence form only. If there are more limitations than one in a claim, they should be properly separated by semicolons (;) and with a period (.) at the end of the claim.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Regarding claims 1-2, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

### ***Drawings***

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: **44**. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 1 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Goyette (5322293).

Goyette teaches a racing board game permitting model racing cars (58), a pair of six sides dice (56), starting space and finishing spaces (Fig.1), and further number of spaces varying (three lanes having 16,20,28 spaces).

Examiner notes that applicant's "inversely proportional rule" is not true to its' words as understood by the examiner. Using the same definition Goyette lanes can be treated as having number of spaces inversely proportional to possible frequencies of roll sums.

Although this is not expressly demonstrated by Goyette, the fact that Goyette lanes have varying number of spaces is applicant's, suggests at possibility of following the "inversely proportional rule".

Further claim 1 is an apparatus claim and rules for playing such as "method to govern movement based on adjusted probability" do not further limit the apparatus in the claim.

In order to make the game interesting, it would have been obvious to use varying number of spaces per lane.

One of ordinary skill in art at the time the invention was made would have suggested modifying and using varying number of spaces per lane to make the game interesting.

10. Claim 1 rejected under 35 U.S.C. 103(a) as being unpatentable over Goyette in view of Welsh (4729568).

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Goyette teaches a racing board game permitting model racing cars (58), a pair of six sides dice (56), starting space and finishing spaces (Fig.1), and further number of spaces varying (three lanes having 16,20,28 spaces).

Examiner notes that applicant's "inversely proportional rule" is not true to its' words as understood by the examiner. Using the same definition Goyette lanes can be treated as having number of spaces inversely proportional to possible frequencies of roll sums. Although this is not expressly demonstrated by Goyette, the fact that Goyette lanes have varying number of spaces is applicant's, suggests at possibility of following the "inversely proportional rule".

Further claim 1 is an apparatus claim and rules for playing such as "method to govern movement based on adjusted probability" do not further limit the apparatus in the claim. In order to make the game interesting, it would have been obvious to use varying number of spaces per lane.

However applicant might argue that Goyette does not teach assigning total sum numbers of rolling to space numbering.

Welsh teaches assigning each player and space to a total sum of roll for moving and also making number of spaces inversely proportional to the sum of dice rolls (Fig.1, 3:34-57).

One of ordinary skill in art at the time the invention was made would have suggested modifying and using varying number of spaces per lane to make the game interesting.

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11. Claim 2 rejected under 35 U.S.C. 103(a) as being unpatentable over Goyette in view of Patridge (3738659).

Goyette teaches all limitations of this claim including a pit pass (38), flags (6:23, 7:61), except that it does not teach chips, winner cups and tire haulers.

Patridge teaches chips (Fig.14), cups (Fig.16) and tire haulers (Fig.15).

Board game is a highly competitive art area. In order to make the game attractive, it would have been obvious to provide articles that would make the game simulate a real race. One of ordinary skill in art at the time the invention was made would have suggested providing such articles to make the game attractive.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Frank-Opigo (5624120) teaches using "inversely proportional rule" for making the apparatus.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vishu K Mendiratta whose telephone number is (571) 272-4426. The examiner can normally be reached on Mon-Fri 8AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on (571) 272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Vishu K Mendiratta  
Primary Examiner  
Art Unit 3711

VKM  
February 17, 2005